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| 10/574,016 | 03/29/2006 | Yuji Ueno | Q107169 | 4347 |

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| EXAMINER | |
|---|---|
| KIM, YUNSOO | |
| ART UNIT | PAPER NUMBER |
| 1644 | |
| MAIL DATE | DELIVERY MODE |
| 01/30/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/574,016 | UENO ET AL. | |
| | Examiner | Art Unit | |
| | YUNSOO KIM | 1644 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *04 November 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-11 and 14-21* is/are pending in the application.

4a) Of the above claim(s) *1-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/29/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

**DETAILED ACTION**

1. Claims 1-11 and 14-21 are pending.

Claims 1-11 stand withdrawn from further consideration by the examiner under 37CFR 1.142(b) as being drawn to a nonelected invention.

Claims 14-21 drawn to a solution-type antibody preparation are under consideration in the instant application.

2. Applicant's IDS filed on 12/28/08 is acknowledged.

3. In light of Applicant's amendment to the claims and the response filed on 11/4/08, no rejections of record remain.

4. Upon further consideration, the following rejections are set forth herein.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14-21 are rejected under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim recites "a solution-type antibody preparation", yet the claim then recites that glycine and citric acid are added to suppress formation of a soluble solution. If solubility is suppressed, how does one make an antibody solution?

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1174148A1 (IDS reference, newly cited) in view of U.S. 2003/019316A1, of record.

The '148 publication teaches an antibody formulation comprising a humanized antibody, sodium citrate and a non-ionic surfactant (claims 1-8). The '148 publication further teaches the concentration of the antibody is 5-50 mg/ml ([0008]), pH of the preparation ranges 4.9-5.95 and the buffer concentration of 10mM (table 1, [0028-0029]).

As the specification of the instant application discloses (p. 17) the sodium citrate as a preferred example of citric acid, the referenced "sodium citrate" meets this limitation.

Further, the '148 publication teaches that the buffers may be used alone or as a combination of two or more and the exemplary buffers include phosphate, citrate, acetate, tartarate, malate, and arginine ([0014], claims 6-7) and a further addition of polysorbate (claim 8) in the presence of sodium citrate and/or phosphate.

The disclosure of the '148 publication differs form the instant claimed invention in that it does not teach the addition of glycine and a concentration of 10-30 mg/ml as is currently recited in claims 14 and 16 of the instant application.

The '316 publication teaches addition of glycine improves stabilization of preparation as it reduces aggregation ([0089]). The '316 publication teaches the glycine concentration of 200mM (example 4)

which is equivalent to 15mg/ml as the molecular weight of glycine is 75g (see section 8 of the office action mailed 8/4/09).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add glycine and/or substitute other buffers with glycine as taught by the '316 publication to the antibody formulation as taught by the '148 publication.

One of ordinary skill in the art at the time the invention was made would have been motivated to do so because the addition of glycine improves the stability of the antibody formulation by reducing aggregation. Therefore, it is prima facie obvious to combine two compositions each of which is taught by prior art to be useful for same purpose in order to form third composition that is to be used for very same purpose; idea of combining them flows logically from their having been individually taught in prior art. In re Kerkhoven, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06

From the teachings of references, it would have been obvious to one of ordinary skill in art to combine the teachings of the references and there would have been a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of the ordinary in the art at the time of invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1174148A1 (IDS reference, newly cited) in view of U.S. 2003/019316A1, of record, as applied to claims 14-20 above, and further in view of U.S. Pat. No. 6,488,930B1, of record.

The '148 publication and the '316 publication have been discussed, supra.

The disclosure of the '148 publication and the '316 publication differs form the instant claimed invention in that it does not teach a humanized antibody to CCR4 as is currently recited in claim 21 of the instant application.

The '930 patent teaches a composition comprising a humanized CCR4 antibody (claims 6 and 47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the stabilizing formation taught by the '148 publication and the '329 publication into a CCR4 humanized antibody taught by the '930 patent.

One of ordinary skill in the art at the time the invention was made would have been motivated to do so because the formulation taught by the '148 and the '329 publications improve stability of the antibody formulation.

From the teachings of references, it would have been obvious to one of ordinary skill in art to combine the teachings of the references and there would have been a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of the ordinary in the art at the time of invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1174148A1 (IDS reference, newly cited) in view of U.S. 2003/019316A1, of record, as applied to claims 14-20 above, and further in view of U.S. Pat. No. 6,437,098B1, of record.

The '148 publication and the '316 publication have been discussed, supra.

The disclosure of the '148 publication and the '316 publication differs form the instant claimed invention in that it does not teach a humanized antibody to ganglioside GD3 as is currently recited in claim 21 of the instant application.

The '098 patent teaches a humanized ganglioside GD3 antibody (claims 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the stabilizing formation taught by the '148 publication and the '329 publication into a humanized ganglioside GD3 taught by the '098 patent.

One of ordinary skill in the art at the time the invention was made would have been motivated to do so because the formulation taught by the '148 and the '329 publications improve stability of the antibody formulation.

From the teachings of references, it would have been obvious to one of ordinary skill in art to combine the teachings of the references and there would have been a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of the ordinary in the art at the time of invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

11. No claims are allowable.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YUNSOO KIM whose telephone number is (571)272-3176. The examiner can normally be reached on M-F,9-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen B. O'Hara can be reached on 571-272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yunsoo Kim
Patent Examiner
Technology Center 1600
January 23, 2009

/Michael Szperka/
Primary Examiner, Art Unit 1644